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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,229	11/06/2001	Chisato Hirata	ACE-1001	5572
7590	07/27/2004			
Mitchell P Brook Luce Forward Hamilton & Scripps 11988 El Camino Real Suite 200 San Diego, CA 92130			EXAMINER MAI, TRI M	
			ART UNIT	PAPER NUMBER
			3727	

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/009,229

Applicant(s)

HIRATA, CHISATO

Examiner

Tri M. Mai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-19 is/are pending in the application.
- 4a) Of the above claim(s) 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 13-17 and 19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Group I: the ornamental portion having an animal or human shape

Group II: the ornamental portion having an automobile or rocket shape.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Newly submitted claim 18 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claim is specific to an automobile of rocket design.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 18 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Furthermore, it is noted that the automobile and rocket in claim 18 must be shown according to 37 CFR 1.83(a) and the claim is objected to as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Claim Rejections - 35 USC § 103

2. Claims 13, 14, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Ota et al. or Vaillencourt, in view of Becker (D187435). Each of Ota, and Vaillencourt

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teaches a container with decompression panels. Becker teaches that it is known in the art to provide a figurine shape for a bottle. It would have been obvious to one of ordinary skill in the art to provide a figurine shape for a bottle in anyone of Ota, and Vaillencourt, as taught by Becker to attract customer and/or to provide an alternative gripping portion.

With respect to the elliptical cross section, it is noted that matter relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Furthermore, the neck portion of the animal in Becker does not exceed the circumference of the base portion.

3. Claims 13-15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carew in view of either Becker (D187435). Carew teaches a container with decompression panels. Becker teaches that it is known in the art to provide a figurine shape for a bottle. It would have been obvious to one of ordinary skill in the art to provide a figurine shape for a bottle in anyone of Carew as taught by Becker to attract customer and/or to provide an alternative gripping portion.

With respect to the elliptical cross section, it is noted that matter relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Furthermore, the neck portion of the animal in Becker does not exceed the circumference of the base portion.

4. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over the rejection of anyone of Ota et al. or Vaillencourt, or Carew rejections, as set forth above in paragraphs 2 and

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3, and further in view of either De Kolb (D192390) or JP952570. It would have been obvious to one of ordinary skill in the art to provide a cap in the shape of a hat in anyone of Ota et al. or Vaillencourt, or Carew rejections as taught by De Kolb (D192390) or JP952570 to provide a matching cap with the container.

5. Claims 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Ota et al. or Vaillencourt, or Carew in view of Hager et al. (D416480). Each of Ota, Vaillencourt, and Carew teaches a container with decompression panels. Hager teaches that it is known in the art to provide a figurine shape for a bottle. It would have been obvious to one of ordinary skill in the art to provide a figurine shape for a bottle in anyone of Ota, Vaillencourt, and Carew and as taught by Hager to attract customer and/or to provide an alternative gripping portion.

With respect to the elliptical cross section, it is noted that matter relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Furthermore, the neck portion of the animal in Becker does not exceed the circumference of the base portion.

Response to Arguments

6. Applicant's arguments filed 04/09/04 have been fully considered but they are not persuasive. As set forth above, the invention is directed to an ornamental portion which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). With respect to the container having a cross section being less than the circumference of the bottle. It is noted that this is very

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old in the art as it is taught in all applied references. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (703)308-1038. The examiner can normally be reached on 7:30am-5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W Young can be reached on (703)308-2572. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tri M. Mai
Primary Examiner
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